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09/921,397	08/02/2001	Pierre Legrain	EGYPSA-013	6024

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EXAMINER

MOSHER, MARY

ART UNIT

PAPER NUMBER

1648

12

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,397

Applicant(s)

Legrain et al

Examiner

Mosher

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-73 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-73 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other:

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***Election/Restriction***

The reply filed on February 19, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): applicant failed to elect ONE invention from the groups listed. See 37 CFR 1.111.

Applicant has treated the restriction as an invitation to elect 10 sequences, citing MPEP 803.04, which quotes the notice of 1192 O.G. 68 (November 19, 1996). However, the action, as written, requires applicant to choose one invention. In addition, the practice set forth in MPEP 803.04 is NOT intended to cover situations, as in this case, where the nucleotide sequences are either known or suggested to code for specific polypeptide sequences. Moreover, in the 6 years since the O.G. notice was issued, growth in sequence databases has been exponential, requiring an exponential increase in the resources required to search the prior art. The database doubles in size every six months. Search of more than one patentably distinct sequence per application therefore has become unduly burdensome. Furthermore, the original notice was directed to election of 10 specific nucleotide sequences, and the claims of this application are directed to degenerate coding sequences, not specific nucleotide sequences. Search of a claim to one coding sequence requires search of a multiplicity of nucleic acid sequences, which adds to the burden of search. Therefore, each sequence (and its fragments and variants) is listed as a separate invention. Accordingly, the Office reiterates the requirement that applicant elect a SINGLE invention as set forth in the previous Office action, and as modified below.

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Applicant points out that claims 24 and 26 are actually drawn to sets of two polypeptides and complexes, and that claim 22 is drawn to a set of two nucleic acids, and argues that the claims are misgrouped. However, although the claim preamble recites "nucleic acid" in claim 22, the sequences recited in the claim are amino acid sequences. Likewise, claims 24 and 26 recite "polypeptide" in the preamble, but the sequences recited in the claims are nucleic acids. Therefore it is maintained that these claims are not misgrouped.

Applicant convincingly argues that claim 63 is not drawn to the drawn to the same invention as claim 64, since claim 64 is drawn to a treatment method using a nucleic acid.

Therefore, the restriction requirement is revised as follows:

Groups 267 - 304, claim 63, are drawn to methods of treatment using the 38 distinct polypeptide products of sequences 1-38, classified in class 514, subclass 12.

New groups 308-345 Claim 64, drawn to methods of treatment using the distinct nucleic acids of groups 39-76, classified in class 514, subclass 44.

Groups 308-345 are related to groups 39-76 as product and method of use; as discussed on page 4 of the original restriction requirement, the nucleic acids of groups 39-76 can be used in a number of materially different methods, such as producing isolated proteins, or in the two distinct assays of groups 115-172 or 229-266. Each method of use requires divergent search.

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If a product is found to be allowable, process claims which include all the limitations of the allowable product claim will be rejoined. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

Until a product is found allowable, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

May 5, 2003

  
**MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1800**